



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Kenji SAMOTO

Group Art Unit: 2174

Application No.: 10/669,687

Examiner: J. LEE

Filed: September 25, 2003

Docket No.: 117213

For: FLEXIBLE CABLE HARNESS AND IMAGE FORMING APPARATUS

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer dated September 7, 2007.

Appellant responds to the arguments presented on pages 3 and 4 of the Examiner's Answer. Appellant asserts that (1) independent claims 1 and 19, which are the only independent claims, do not recite a method of forming a device, and that all features of claims 1 and 19 must be given patentable weight, (2) it is not routine skill in the art, nor is it predictable, to add structure that does not exist in the prior art, and (3) the Examiner's Answer again fails to clarify where JP'949 discloses or suggests first and second positioning systems that can be added to each of the flexible cables.

(1) ALL FEATURES OF CLAIMS 1 AND 19 MUST BE CONSIDERED

Claims 1-6, 19 and 20 are rejected under 35 U.S.C. §103(a) over JP-U-6-21949 (JP'949). Appellant argued in the May 23, 2007 Appeal Brief that JP'949 fails to disclose or suggest a flexible cable harness with a plurality of flexible cables, each of the plurality of flexible cables comprising (1) a first positioning system added near the first end (each flexible cable having a first end); and (2) a second positioning system added near the second end (each flexible cable have a second end) as recited in each independent claim, independent claims 1 and 19. See Section VII., B. of the Appeal Brief.

To support this argument, Appellant argued, among other things, that both JP'949 and Appellant use similar flexible cables and that Appellant adds structure (i.e., first and second positioning systems) to their flexible cables when JP'949 fails to add any structure to their similar cables 13-17. See Section VII., B., 1., b., page 15, of the Appeal Brief

Page 3 of the Examiner's Answer responds to this argument by stating that "the method of forming a device is not germane to the issue of patentability of the device itself. Therefore, this limitation is not given patentable weight in a device claim." Appellant asserts that this response reflects a misunderstanding of claims 1 and 19 and the arguments presented in the Appeal Brief.

Appellant never argues the method of forming a device. Appellant always argues that JP'949 fails to disclose the structure of apparatus claims 1 and 19. In particular, JP'949 fails to disclose or suggest a flexible cable harness with each of a plurality of flexible cables comprising a first positioning system added near a first end and a second positioning system added near a second end, as recited in claims 1 and 19. Although JP 949 disclose a flexible cable harness with a plurality of flexible cables, JP'949 fails to disclose or suggest the additional structure of a first positioning system and a second positioning system added to the cables 13-17.

Even if the Examiner believes that claims 1 and 19 recite a method of forming a device as stated on page 3 of the Examiner's Answer, Appellant fails to see how no patentable weight can be given to the final structure created by a first positioning system added near a first end and a second positioning system added near a second end, as recited in claims 1 and 19. This is contrary to the examination guidelines presented in the MPEP, in particular MPEP 2113, and the relevant case law, in particular, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) and *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

(2) IT IS NOT OBVIOUS TO ADD STRUCTURE THAT DOES NOT EXIST

Page 3 of the Examiner's Answer alleges that it is "routine skill in the art of construing a formally integral structure in various elements." Although this statement is not clear, Appellant believes that the Examiner is asserting that it is routine skill in the art to have a first positioning system and a second positioning system added near the ends of each of a plurality of flexible cables. Appellant disagrees.

As noted in Section VII., B., 1., a. and b. of the Appeal Brief, JP'949 simply discloses a flexible harness cable with cables 13-17 that are placed inside an image forming apparatus. JP'949 fails to disclose any structure that is added to the cables 13-17. JP'949 simply discloses cables 13-17 that are placed in an image forming apparatus. Giving independent claims 1 and 19 the broadest reasonable interpretation consistent with the specification, JP'949 must have some structure that is added near the ends of each of the cables 13-17 (that is not a part of the image forming apparatus) in order to position the cables 13-17. Appellant fails to see how it can be predictable or routine skill in the art to add a first positioning system and a second positioning system when JP'949 fails to disclose or suggest any structure and Appellant has identified advantages associated with using a first positioning system and a second positioning system. The previous Office Actions and the Examiner's Answer also fail to

establish that there is a small number of possible structures that can be added to JP'949's cables 13-17 in order to make it predictable or routine skill in the art to add a first positioning system and a second positioning system.

(3) THE EXAMINER'S POSITION IS NOT CLEARLY ARTICULATED

Pages 3 and 4 of the Examiner's Answer again attempts to point out the first positioning system and the second positioning system in JP'949. However, page 4 of the Examiner's Answer again does not clearly explain the Examiner's position. For example, page 4 of the Examiner's Answer appears to point to a wall of the image forming apparatus for the alleged first positioning system. It is not clear how this alleged wall is added near an end of each of the plurality of cables 13-17.

Contrary to page 3 of the Examiner's Answer, it is not contradictory to assert that JP'949 fails to disclose all of the features recited in claims 1 and 19 and to also state that the Examiner has not clearly explained what the Examiner considers to be the first positioning system and the second positioning system. See Section VII., B., 1., c. of the Appeal Brief.

It is respectfully submitted that the remaining points of argument set forth in the Examiner's Answer were fully addressed in Appellant's Appeal Brief. For at least the reasons set forth herein and in the Appeal Brief, it is respectfully submitted that all claims are in condition for allowance.

Respectfully submitted,



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